

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Art Unit 3625  
Davis et al. Confirmation No. 5321  
Application No.: 09/502,542  
Filed: February 10, 2000  
For: METHOD AND SYSTEM FOR  
FACILITATING ON-LINE SHOPPING **VIA ELECTRONIC FILING**  
Examiner: M. Fadok  
Date: March 2, 2009

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

Appellants request review of the final rejection of claims 7, 21, 26, 31, 33 and 34 in the above-identified application. No amendment is being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheets. (No more than 5 pages are provided.)

Date: March 2, 2009

Respectfully submitted,  
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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

## **REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW**

This application was earlier appealed, and the Office was affirmed. The Board's detailed 50 page opinion included helpful commentary about the shortcomings of the then-pending claims, and how they might be revised to overcome the art. The claims now appealed follow the Board's guidance.

In the present appeal the Board will reverse the rejections. A few reasons for reversal are noted below.

Claim 31 is rejected under Section 112, second paragraph, due to alleged ambiguity of the phrase "as if the purchases were made online."

The Board will not find the claim "insolubly ambiguous."<sup>1</sup> Indeed, taken in context, the language is quite clear. Including clarifying claim language omitted in the Final Rejection, the claim states: "...fulfilling said purchases as if the purchases were made online, by passing said list to a third party fulfiller different than a provider of the mall storefront." The underlined language specifically details what is meant by the claim limitation. The Board will reverse.

Claim 33 is rejected over Swartz (6,243,447) in view of *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Swartz discloses a self-checkout system for a retail store, in which a shopper equipped with a personal barcode scanner scans items put into their grocery cart, thereby generating a list. At the checkout register, a cashier retrieves the scanned list and charges the shopper accordingly.<sup>2</sup>

Swartz's scanner can also be used to compile a predicted shopping list (based on a shopper's historical shopping practices), which may be retrieved by the shopper for later use at the store.<sup>3</sup>

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<sup>1</sup> This is the standard applied by the Federal Circuit. See, e.g., *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004), cited in MPEP 2173.02.

<sup>2</sup> Swartz, US 6,243,447, col. 3, lines 43-64.

<sup>3</sup> Swartz, US 6,243,447, col. 3, lines 35-39.

The claim reads:

33. A method comprising:

in connection with a user's expression of interest in a first item available for sale from a first vendor, adding information associated therewith to a data structure associated with the user; and  
recalling data from said data structure in connection with presenting to the user information about one or more items offered for sale by a second vendor;  
wherein the first and second vendors are different.

The Final Rejection makes reference to the previous appeal, but that appeal concerned different claims with different limitations. In the present rejection, the Office alleges that all of the claim's limitations are taught by Swartz (so the rejection is more properly a Section 102 rejection):

**First rejections of claims 33 and 34**

In regards to claim 33 Swartz discloses a method comprising: in connection with a user's expression of interest in a first item available for sale from a first vendor, adding information associated therewith to a data structure associated with the user; and recalling data from said data structure in connection with presenting to the user information about one or more items offered for sale by a second vendor; wherein the first and second vendors are different (See Board of appeals response to previous rejection Appeal # 2007-0065 dated 8/22/2007 pages 3-9, 37and 38).

(It will be recognized that this rejection does not comply with MPEP requirements. There is no reference to relevant column or line numbers. There is no statement of the difference(s) in the claim over the art. Etc.)

Substantively, the rejection is ill-founded. Swartz does not teach "recalling data from said data structure in connection with presenting to the user information about one or more items offered for sale by a second vendor; wherein the first and second vendors are different."

Since the rejection is based on an error of fact, the Board will reverse.

Moreover, the Board made a special point of contrasting "distinct" versus "different":

Regarding Appellants' argument (FF 3), it is not persuasive as to error in the rejection. First, Appellants argue that the claim calls for a second vendor that is different from the first. However, the claim only calls for a second vendor "distinct" from the first. There is no requirement that the vendors be different in order to be distinct. Second, Appellants dismiss the

The earlier-appealed claim used “distinct.” The claim now pending uses “different.” The Final Rejection overlooked this point highlighted by the Board.

Again, the Board will recognize the shortcoming, and reverse.

In like fashion the Final Rejection erred in its rejection of claim 34. Contrary to the factual mis-statement in the Action, Swartz does not teach each of the limitations of the claim. The Board will not affirm a rejection based on such an error.

Claim 31 is rejected over Cybul (6,246,997) in view of Loeb (6,360,209). The claim reads:

31. A method comprising:  
providing a mall storefront that displays certain items offered for sale, but does not stock an inventory from which sales of these items can be fulfilled;  
providing a sensor device to a customer; and  
allowing the customer to handle the displayed products and sense machine readable data from products of interest to the customer, generating an electronic list;  
wherein the method includes fulfilling said purchases as if the purchases were made online, by passing said list to a third party fulfiller different than a provider of the mall storefront.

Again, the rejection is based on a mis-reading of the art.

For example, the Action states:

**In regards to claim 31, Cybul discloses a method comprising:**  
providing a mall storefront that displays certain items offered for sale, but does not stock an inventory from which sales of these items can be fulfilled (col 4, lines 48-67);

Inspection of Cybul at col. 4, lines 48-67 reveals the error. There is no teaching of a storefront that displays certain items offered for sale, but does not stock an inventory from which sales of these items can be fulfilled. Instead, the cited passage is silent on such a limitation:

tated by the architecture of the POS system. At a minimum, the POS system must provide a loyalty program, that is a frequent shopper card, or the electronic equivalent, and track purchases based on the loyalty or frequent shopper card identification. Future POS systems need only to incorporate these elements into their basic design.

Basic information about the loyalty customers or frequent shoppers is kept in a first database. This database can 55 contain, without limitation: a frequent shopper identification (FSID), preferred payment methods and demographic information such as name, address, family size, number of children and the like. This information is used to locate the shopper's purchase history via the FSID. Optionally, some 60 or all of this data may be returned to the shopping list builder tool to support custom profile and configuration features unique to a particular shopping list builder tool.

A second database of historical purchase data, indexed by 65 loyalty customer, is defined by the POS system and should minimally contain, on a per loyalty customer basis, a purchase time stamp and a list of items purchased. For each item on a given list, the following information should be

Because the rejection is premised on Cybul teaching a storefront that does not stock an inventory, when there is no such teaching, *prima facie* obviousness has not been established and the Board will reverse.

In addition to the Swartz-based rejection of claim 34 noted above, the claim is also rejected over Cybul in view of Walter (6,334,110). The Rejection notes that Walter teaches collecting shopping data from both on-line and brick & mortar stores, and proposes use of this consolidated data to populate Cybul's on-line session.

However, Walter relates to a different field than claim 34. Walter concerns analyzing the timing between a user's activities in a physical store, and in an on-line store, to try and identify if there are time-of-day or other factors that lead a user to make a purchase (or not make a purchase). As Walters explains:

The present invention addresses the need to temporally analyze customer transactions (i.e., purchases) and customer interactions (i.e., browsing on retail sites of the World Wide Web of the Internet). In other words, this invention analyzes customer behaviors based on the time when those behaviors occur. The invention captures information about customer interactions and transactions over time, classifies customers into one or more clusters based on their time-based interactions and transactions, or both, and uses this classification to perform selected target marketing or cross-selling.

Only by impermissible hindsight would an artisan have combined Walter with Cybul in the manner asserted.

Claims 7 and 21 seem rejected by the same analysis, but the claims are different. (See pages 7-9 of the Final Rejection, and duplicated text concerning claim 21.)

The Final Rejection includes a second rejection of claim 33 (in addition to the Swartz-based rejection discussed above) – this one over Trotta and Cybul. However, the rejection merely quotes the claim language and states that same is taught by Trotta and Cybul. However, there is no indication of how the art is applied; which shortcoming of Trotta is allegedly cured by Cybul, etc. The rejection concludes with a reference to claim 26 – which presents different limitations.

Claim 26 is rejected over Trotta, Cybul, Deaton (6,993,498) and Official Notice. The combination is said to be obvious because Deaton teaches utilizing a shopping list to effect a later transaction (Final Rejection, top of page 13), and “because this will provide comparison information for a more informed decision.”

The claim does not relate to comparison information. The Board will not find the stated rationale persuasive.

The foregoing is believed sufficient to establish that the rejections will not be sustained. Accordingly, Appellants do not belabor this paper with additional remarks on the rejections, the art, or the claims – all of which are reserved for presentation to the Board.